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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,018	11/20/2000	Jay A. Endsley	81086PF-P	9633

7590 02/14/2005

Patent Legal Staff  
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Rochester, NY 14650-2201

EXAMINER
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MOE, AUNG SOE

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 02/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/718,018

Applicant(s)

ENDSLEY ET AL.

Examiner

Aung S. Moe

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/10/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Species II of Figs. 2, 3B and 4 and claims 1-4 and 7-9 as set forth in the reply filed on 12/8/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 5-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/8/2004.

### *Drawings*

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the original drawings are found to be "**informal**" and the description of some of the figures are not cleared. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by Ward et al. (U.S. 6,784,924).

Regarding claim 7, Ward '924 discloses a method for transferring digital images using a camera (10) having capture device (22) for capturing the digital images, a digital memory (30/28) for storing the captured digital images, communication means (32/36) for transmitting the captured digital images to a service provider (14/10), and a display (24) for displaying digital files stored in the digital memory (30/28), comprising the steps of:

transferring at least one digital image to said service provider (14/10) (see Figs 2; col. 3, lines 40+) using the communication means (32/36);

receiving from said service provider (14/10) at least one order status confirmation file (i.e., noted the network configuration files as shown in Fig. 4A-4B and the "utilization" files provided by the host PC 12) and storing said file in said digital memory (i.e., col. 3, lines 5-40); and displaying the at least one order status confirmation file on the display (i.e., see col. 3, lines 15-65).

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6. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Tsubaki (U.S. 6,701,058).

Regarding claim 8, Tsubaki '058 discloses a method for transferring digital images using a camera (10) having a capture device(11) for capturing digital images, a digital memory (13) for storing a plurality of captured digital images, and communication means (14) for transmitting the captured digital images to a service provider (20) (i.e., see col. 1, lines 35+), comprising the steps of:

capturing a plurality of digital images (Fig. 3, the step S12); determining whether a preset number of digital images has been captured (Fig. 3, the steps S14-S18); and

automatically transferring the plurality of captured digital images (i.e., Figs. 3, the steps S26; col. 11, lines 15+) to the service provider (20) via the communication means (14) when the preset number of images (col. 8, lines 5+) has been captured.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being obvious over Tsubaki (U.S. 6,701,058) in view of Ward et al. (U.S. 6,784,924).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C.

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102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 9, it is noted that Tsubaki ‘058 does not explicitly show the steps of: receiving from the service provider at least one order status confirmation file and storing said file in said digital memory; and displaying the at least one order status confirmation file on a display as recited in the present claimed invention.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Ward ‘924. In particular, Ward ‘924 shown show the steps of: receiving from the service provider at least one order status confirmation file and storing said file in said digital memory; and displaying the at least one order status confirmation file on a display as recited in the present claimed invention (i.e., see Figs. 1 and 2; col. 2, lines 60 – col. 3, lines 40).

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In view of the above, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Tsubaki '058 as taught by Ward '924, since Ward '924 stated in col. 1, lines 40+ such a modification would provide an easy-to-use means with buttons or menus on a small digital camera to input and/or modify all the required settings.

***Allowable Subject Matter***

9. Claims 1-4 are allowed.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

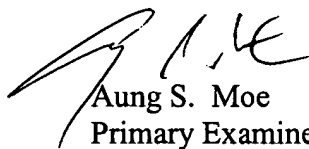
- a. Parulski '961 and Fredlund '962 are related invention of the present claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aung S. Moe whose telephone number is 703-306-3021. The examiner can normally be reached on Mon-Fri (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy Garber can be reached on 703-305-4929 (or 571-272-7308). The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Aung S. Moe  
Primary Examiner  
Art Unit 2612

A. Moe  
February 11, 2005